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| APPLICATION NO.                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 09/761,797                       | 01/17/2001  | Jon E. Stickrod      | 55716US2A.002       | 5943             |
| 32692                            | 7590        | 01/29/2004           | EXAMINER            |                  |
| 3M INNOVATIVE PROPERTIES COMPANY |             |                      | AHMAD, NASSER       |                  |
| PO BOX 33427                     |             |                      | ART UNIT            |                  |
| ST. PAUL, MN 55133-3427          |             |                      | PAPER NUMBER        |                  |

1772

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/761,797

Applicant(s)

STICKROD, JON E. 

Examiner

Nasser Ahmad

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6/01; 5/03 .                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 6, 9-11 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundet (5,665,446) in view of Futhey (5,840,407).

Sundet relates to a decorating assembly comprising a laminate that is transparent and comprises a cover sheet with a layer of pressure sensitive adhesive (PSA) on one surface thereof. Both the cover sheet and the PSA layer are vented or perforated and a release liner is provided for the adhesive (abstract and figure-2). However, Sundet fails to teach the presence of pieces of optical film with adhesive in the kit assembly. Futhey discloses an assembly comprising pieces of optical film provided with adhesive on one surface thereof and covered with a release liner (abstract and col. 4, lines 1-3). Futhey teaches the advantage of using optical film with adhesive to form simulated decoration. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Futhey's teaching to provide optical film pieces with adhesive in the invention of Sundet with the motivation that it would provide for a kit which includes the optical film for decorative purposes.

As for claims 18 and 19, the process steps are not germane to the issue of patentability of the product itself and hence, have not been given patentable weight.

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As for process claims 1-2, 6 and 9-11 , the Sundet reference teaches the steps of providing a kit , placing the optical film pieces on a common plane, adhering the pieces onto the laminate cover, placing the formed composite onto a substrate, pressing the air out from between the substrate and removing the laminate cover (col. 2, line 8 to col. 3, line 15). However, Sundet fails to teach the presence of the optical film as the pieces. Futhey, as discussed above, teaches the advantage of providing optical film for decorative purpose. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Futhey's teaching of providing the optical film pieces in the invention of Sundet with the motivation to provide for a kit for decorating a substrate.

3. Claims 3-5, 7-8, 12-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundet in view of Futhey and McNaul (5,225,260).

Sundet and Futhey, as discussed above, fails to teach that the kit comprises a predetermined printed design. McNaul teaches a laminate comprising an application tape (24) having printed design (50) on one of the surface thereof. McNaul teaches the advantage of the presence of the print that provides for alignment of the sign components. Therefore, it would have been obvious to one having ordinary skill in the art to utilize McNaul's teaching of providing grid lines as preprinted design in the invention of Sundet with the motivation to provide for alignment guidance of the pieces laminated thereon.

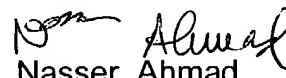
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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-308-0661.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
January 25, 2004.